

### **REMARKS**

In the Office Action, claims 1, 2, 4-17, and 19-32 were rejected. By the present response, claims 1, 2, 4-17, and 19-32 will be pending in the present patent application. Reconsideration and allowance of all pending claims are requested in view of the points set forth below.

#### **Petition to Withdraw Finality**

The Examiner indicated that the current Office Action has been made final. Applicants submit that the finality of the Action is improper. In particular, in the "Office Action Summary", Examiner lists claim 32 under the "Disposition of Claims" as rejected. However, no prior art rejection was formulated against claim 32 in the "Detailed Action". Clearly, the Applicants have not been placed on notice of rejection of at least claim 32. Accordingly, Applicants have not been given a fair opportunity to argue the patentability of claim 32. Moreover, the Examiner did not explain any basis for rejecting claim 32. For at least these reasons, the finality of the current Action should be withdrawn, and the Examiner should present a cogent *prima facie* case against claim 32 in a proper non-final Action.

#### **Rejections Under 35 U.S.C. § 102**

In the Office Action, claims 1, 2, 4-10, 13-17, 19, and 22-31 were rejected under 35 U.S.C. §102(b) as being anticipated by Dumoulin '635. A *prima facie* case of anticipation under 35 U.S.C. §102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). Applicants respectfully assert that the present invention, as recited in independent claims 1, 13, 23 and 32 is patentable over Dumoulin '635.

Independent claims 1, 13, 23 and 32 recite, in generally similar language, *repositioning the medical device within the target region of interest without moving the subject.*

Dumoulin '635 discloses stereoscopic tracking of the three-dimensional position and orientation of an invasive device within a subject without using X-rays. However, *Dumoulin '635 fails to disclose or suggest positioning of the medical device within the target region of interest without moving the subject.* Applicants respectfully submit that the positioning of the medical device within the target region of interest may be achieved in the present application by moving the medical device itself.

The Examiner, in his response to arguments, stated that Dumoulin '635 discloses a device for repositioning a medical device within the target region of interest without moving the subject. However, *Dumoulin '635 actually discloses automatic placement and alignment of the subject by use of a support arm within a desired region around invasive device (See, column 7, lines 24-27).* Clearly, *automatic placement and alignment of the subject by use of a support arm within a desired region around invasive device* is not same as *positioning a medical device within the target region of interest without moving the subject.*

The Examiner, in his response to arguments, further stated that the imaging device disclosed in Dumoulin '635 is capable of both translational and rotational motion to facilitate any modifications in the area to be imaged. It is thus understood that the subject of the procedure would not be required to move during tracking and imaging. Even if this were true, Applicants respectfully submit that tracking and imaging a medical device within a subject without moving the subject cannot be interpreted as positioning a medical device within the target region of interest without moving the subject.

Moreover, *the present application, discloses a positioning subsystem that is configured to respond to motion of at least one of the medical device or the subject in a predetermined or pre-programmed fashion when the position of the medical device deviates from the target region of interest.* (See, Application, page 10, lines 7-12; See also, page 9, lines 12-16). The Examiner argued that Dumoulin '635 teaches a monitoring subsystem that is responsive to the movement of the medical device relative to the target region within the subject by activating the imaging system to acquire a new image. The examiner further argued that the monitoring subsystem disclosed in Dumoulin '635 provides advisory feedback to the interface unit when the medical device deviates from a target position via a visual icon representing the position of the device. Additionally, the Examiner argued that the feedback provided to the interface can be used to navigate the device to a region of interest.

Applicants, here again, respectfully submit that Dumoulin '635 does not disclose or suggest a monitoring and positioning subsystem as recited in the claims. The monitoring subsystem disclosed in Dumoulin '635 is configured only to track the medical device within the subject by repeated acquisition of images. *Dumoulin '635 do not disclose a predetermined or pre-programmed response such as terminating therapy or repositioning the medical device within the target region of interest without moving the subject or activating an audio or a text advisory feedback to the interface unit.*

Further, the Examiner argued that Dumoulin '635 discloses positioning a medical device within the target region of interest without moving the subject as a predetermined response. However, as stated above, Dumoulin '635 discloses *automatic placement and alignment of the subject by use of a support arm within a desired region around invasive device based on the feedback and not navigating or repositioning the "medical device" during the medical procedure without moving the subject based on the feedback to the interface unit.*

Applicants, therefore, believe that in absence of the positioning subsystem that is configured to respond in a predetermined or pre-programmed fashion as described above, the present invention, as recited in the claims, is not enabled by Dumoulin '635.

At least because Dumoulin '635 fails to disclose or suggest a positioning subsystem that is configured to reposition the medical device within the target region of interest without moving the subject, as claimed, the reference cannot support a *prima facie* case of anticipation of claims 1, 13, 23 and 32. Claims 2, 4-10, 14-17, 19, 22 and 24-31 depend directly or indirectly from claims 1, 13, 23 and 32 respectively. Accordingly, the Applicants submit that claims 2, 4-10, 14-17, 19, 22 and 24-31 are allowable by virtue of their dependency from allowable base claims. Applicants also submit that the dependent claims are further allowable by virtue of the subject matter they separately recite. Thus, it is respectfully requested that the rejection of claim 1, 2, 4-10, 13-17, 19, and 22-32 under 35 U.S.C. §102(b) be withdrawn.

#### **Rejections Under 35 U.S.C. § 103**

In the Office Action, claims 2, 11, 12, 20 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dumoulin '635 in view of Panescu. Claims 6, 17, and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dumoulin '635 in view of Twiss et al., U.S. Patent No. 5,375,596. Claims 1, 2, 4-10, 13-17, 19, and 22-31 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Dumoulin '165 in view of Dumoulin '635. Claims 2, 11, 12, 20 and 21 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Dumoulin '165 in view of Dumoulin '635 and further in view of Panescu.

For the same reasons set forth above, Dumoulin '635 alone or in combination with Dumoulin '165 does not teach, suggest or disclose each and every aspect of the invention claimed in independent claims 1, 13 and 23. Claims 2, 4-12, 14-17, 19-22, and 24-31 depend directly or indirectly from claims 1, 13 and 23 and are allowable by virtue

of such dependency, as well as for the subject matter they separately recite. Thus, it is respectfully requested that the rejection of claims 1, 2, 4-17, 19-30 under 35 U.S.C. §103(a) be withdrawn.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: 11/3/2006

PS  
Patrick S. Yoder  
Reg. No. 37,479  
FLETCHER YODER  
P.O. Box 692289  
Houston, TX 77269-2289  
(281) 970-4545